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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,874	09/12/2001	Irwin Jerold Singer	17037A	8268
23556	7590	12/05/2003	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. 401 NORTH LAKE STREET NEENAH, WI 54956			SALVATORE, LYNDIA	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,874

Applicant(s)

SINGER ET AL.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 46 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and accompanying remarks filed September 8th, 2003 have been carefully considered and entered. Claim 16 has been amended as requested and claims 1-15,46 and 47 have been withdrawn as non-elected. Applicant's amendment to claim 16 has been found sufficient to overcome the objection set forth in section 7 of the last Office Action. As such, this rejection has been withdrawn. Applicant's arguments with respect to claims 16-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Drew, US 6,186,320 in view of McDevitt et al., US 2003/0050589 as set forth in section 13 of the last Office Action have been found persuasive. The present application and McDevitt et al., were under duty of assignment to present Assignee at the time the invention were made As such this rejection is withdrawn. Despite this advance, Applicant's amendments have not been found to patently distinguish the claims over the prior art of record and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Election/Restrictions

2. Applicant's election with traverse of claims 1-15,46 and 47 filed on September 8th, 2003 is acknowledged. The traversal is on the ground(s) that Group I claims and Group II claims are not mutually exclusive species in an intermediate final product relationship. Applicant's arguments are found persuasive with respect to claim 16. However, in reviewing the claims in conjunction with Applicant's arguments, an error on the part of Examiner with respect to the grouping of claims in the restriction was discovered. Claim 16, should have been restricted to Group I (claims 1-15,46 and 47). As originally presented, the Examiner agrees that Group I

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claims and Group II claims, which previously included claim 16, would not be mutually exclusive. However, new Group I, including claim 16 and Group II claims 17-45 are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate of a sensitive surface protective material is deemed to be useful as non-woven fabric, which can be employed in variety of applications ranging from disposable to industrial use. With respect to Applicant's arguments that the intermediate product must lose its identity in the final product, Applicant's independent claim 17 recites interconnecting a first web to the second web having the limitations set forth in originally filed claim 1. Clearly, the surface protecting material loses its identity when integrated with another web layer to become a multi-layer composite. Thus, the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 1-16,46 and 47 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected sensitive surface protection material, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 17 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 17 is indefinite for reciting the physical properties of the non-woven web (i.e., bulk density and Gurley stiffness). *Ex parte Slob*, 157 USPQ 172, states the following with regard to an article claimed by defining property values:

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics, thus, expression "a liquefiable substance having a liquefaction temperature from 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and in effect, recites compositions by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.

Thus, claim 17 is indefinite for reciting only the desired physical properties of the non-woven rather than setting forth structural and/or chemical characteristics of said non-woven. Claims 18-45 are further rejected for their dependency on claim 17.

Applicant argues that the Examiner's reliance on *Ex parte Slob* is misplaced and that presence of physical properties in a claim does not render a claim indefinite (Applicant's response, Page 10). While the mere presence of a property recitation in a claim is not indefinite, the claim must also set forth sufficient structure and chemistry, which would provide for said properties in order to distinguish the instant invention from the prior art. Claim 17 sets forth the

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desired physical properties of bulk density and Gurley stiffness, rather than setting forth the structure, composition, processing methods or chemistry, which would provide for said physical properties. Merely claiming a generic non-woven web having some desired properties potentially encompasses a plethora of materials not yet discovered, which is not part of Applicant's invention.

Reciting the physical and chemical characteristics of the claimed product will not suffice where it is certain that a sufficient number of characteristics have been recited that the claim reads only on the particular compound which the Applicant has invented. *Ex Parte Siddiqui* 156 USPQ 426

Claim Rejections - 35 USC § 102/103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 17-20 stand rejected under 35 U.S.C. 102(e) as anticipated by McDevitt et al., US 2003/0050589 as set forth in section 11 of the last Office Action.

Applicant argues that McDevitt et al., is not available as a reference under 35 U.S.C. 103(a) since the present application and McDevitt et al., were under duty of assignment to present Assignee at the time the invention were made (Applicant's response, page 10). The Examiner agrees, however, McDevitt et al., is not precluded from qualifying as 35 U.S.C. 102(e) art.

Effective November 29, 1999, 35 U.S.C. 103(c) provides that subject matter developed by another which qualifies as "prior art" only under one or more of subsections 35 U.S.C. 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. 35 U.S.C. 103(c) applies only to subject matter which qualifies as

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prior art under 35 U.S.C. 103; **it does not affect subject matter which qualifies as prior art under 35 U.S.C. 102, i.e., anticipatory prior art.** See MPEP § 706.02(l) - § 706.02(l)(3).

With respect to 35 U.S.C. 102(e), Applicant further argues that McDevitt et al., is directed to a disposable finger sleeve whereas the instant invention is directed to a storage sleeve. As such, the Applicant asserts that McDevitt et al., does not anticipate the instant claims (Applicant's response, page 11). This argument is not found persuasive on the grounds that it is the position of the Examiner that intended use of a storage sleeve is not germane to the structure of the McDevitt et al., product. The Examiner asserts that since McDevitt et al., teaches the structural and chemical limitation of the instant invention, the finger sleeve could function as intended by the Applicant.

With regard to the inherency of the claimed Gurley stiffness property as set forth in claims 17 and 18, the Examiner maintains that said properties are inherent to the invention of McDevitt et al. Applicant has not evidenced that said properties are inherent to McDevitt et al. Support for said presumption is found in the use of like materials (i.e., non-woven web of bicomponent filaments and polyethylene or propylene film), which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 17-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew, US 6,186,320 in view of Midkiff et al., US 5,709,735.

The patent issued to Drew teaches a double sided storage sleeve comprising flexible first, third sheet, and a flexible non-woven, non-laminated second sheet positioned between said first and third sheets (Claim 1). The flexible first, third, and second sheet are interconnected together on the bottom edge and two side edges to form two pockets (Claim 1). The flexible non-woven second sheet comprises a spunbonded, continuous polypropylene fiber (Claim 1). The flexible first and third sheets may be comprised of a transparent material such as plastic, vinyl or propylene, or non-woven materials (Column 3, 55-65).

Drew does not specifically teach the limitations set forth in claims, 24-38, however, the patent issued to Midkiff et al., teaches a non-woven web made from conjugate fibers of polyethylene and polypropylene (Abstract). Midkiff et al., that non-woven webs are used in a variety of applications from diapers to protective fabrics (Column 1, 15-18). Specifically, Midkiff et al., teaches spunbond fabrics suitable for use as a filtration material (Column 1, 20-50). Midkiff et al., teaches that the spunbonded polyolefin non-woven fabric has good structural integrity, high permeability and filtration efficiency (Column 1, 35-50). The conjugate polyolefin fibers are spun together to form multi or bicomponent fibers, having a side-by-side or sheath/core configuration (Column 3, 29-45 and Column 6, 66-67). Midkiff et al., teaches various bonding techniques including through-air- bonding (TAB) or thermal point bonding (Column 4, 49-Column 5, 5). Midkiff et al., also teaches using various patterned calendar rolls to produce patterned bonded areas (Column 5, 5-35). With regard to the Gurley stiffness, Midkiff et al., teaches a value above 700 mg

Therefore, motivated by motivated to provide a storage sleeve having sufficient structural integrity it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to employ the spunbonded polyolefin non-woven fabric taught by Midkiff et al., in the double-sided storage sleeve taught by Drew.

With regard to the bulk density limitation recited in claims 17 and 18, the combination of prior art does not disclose the bulk density, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the value of the bulk density as a function of intended final use. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d, 272,205 USPQ 215 (CCPA 1980)

Conclusion


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

November 24, 2003

ls 


CHERYL A. JUSKA
PRINCIPAL EXAMINER